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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,388	04/03/2002	Inge Kruse	100718-354/Beiersdorf 750	9981
7590	08/25/2004		EXAMINER	
Norris McLaughlin & Marcus 30th Floor 220 East 42nd Street New York, NY 10017			CRIARES, THEODORE J	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/980,388	KRUSE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Theodore J. Criares	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 23 June 2004.
- 2a)  This action is **FINAL**.                                    2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 12-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 12-32 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## **CLAIMS 12-32 ARE PRESENTED FOR EXAMINATION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.117(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.117(e) had been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 23, 2004 has been entered with the following effect:

Applicant's arguments with respect to claims 12-32 have been considered but are moot in view of the new ground(s) of rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plaschke (6,409,996 B1) in view of Hegenauer (6,197,813 B1).

The claims in the application are drawn to method for preventing or alleviating sunburn of skin comprising topically applying a composition of at least one ascorbyl compound and at least one flavone derivative.

Plasche discloses the use of flavonoids in the prevention against sunburn at column 1, line 13 to column 2, line 31

At column 4, lines 13 to 62 the ability of flavonoids to act as sun screening agents is taught to have a sun screen protection factor of from 4-8.

Hegenauer at column 1, line 22 to column 2, line 34 the use of Vitamin C to prevent sunburn. There is also disclosed therein various ascorbyl compositions (applicants' claims 15-32) in formulations to treat sunburn.

As stated in *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069, at page 1072 (CCPA 1980):

“It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Susi*, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-277, 126 USPQ 186, 188 (CCPA 1960).

As this court explained in Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. “

In this application it would have been *prima facie* obvious to topically administer a composition of a flavone derivative and an ascorbyl compound to prevent sun burn of the skin.

The amounts of active agents to be used claims 15-17, 19-21 and 26-28 are all within the knowledge of the skilled pharmacologist and represent conventional formulations and modes of administration. The various forms of ascorbyl compounds, claims 13, 14, 18, 22-25 and 29-32 are disclosed in Hegenauer as set forth above.

Applicants' data has been carefully reviewed but fails to provide any surprising or unexpected result over the cited art. There is a lack of criticality set forth in the specification which yields patentability to applicant's claims.

The test of obviousness is “whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention.” *In re Gorman*, 933 F.2d 982, 18 USPQ 2d 1885, (Fed. Cir. 1991). In view of the above rejection it is deemed that

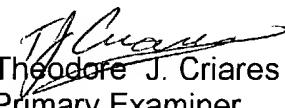
the evidence presented has established a *prima facie* case of obviousness. is presented.

None of the claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Criares whose telephone number is (571) 272-0625. The examiner can normally be reached on 6:30 A.M. to 5:00P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Theodore J. Criares  
Primary Examiner  
Art Unit 1617